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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,922	03/16/2001	William L. Thomas	ODS-38	7120

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EXAMINER	
ASHBURN, STEVEN L	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/809,922	THOMAS, WILLIAM L.	
	Examiner	Art Unit	
	Steven Ashburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-64* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-64* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

Claims 1, 11, 33 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Scagnelli et al., U.S. Patent 5,921,865 (Jul. 13, 1999).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 21-32, 43-48 and 59-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al., U.S. Patent 6,325,716 B1 (Dec. 4, 2001).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claim Rejections - 35 USC § 103

Claims 2-5, 7, 9, 12-15, 17, 19, 34-37, 41, 50-53, 55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Scagnelli* in view of *LottoBot,* http://lotobot.net (Feb, 1999).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 6, 16, 38 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Scagnelli* in view of Luciano et al., U.S Patent 6,168,521 (Jan. 2, 2001).

Scagnelli teaches all the features of the instant claims except a multimedia recording of the lottery drawings associated with the lotteries in which the user participated. Regardless of the deficiency, this feature would have been obvious to an artisan in view of *Luciano*.

Luciano discloses an anolgous electronic lottery game system utilizing multiple player-activated video terminals that are linked to computers. *See abstract.* Each player places a wager and selects his lottery draw choices and the system enrolls the player in a future lottery game after the player makes his choices. *See id.* After automatically drawing lottery numbers, the system displays the result of the selected game displayed at the player's terminal in such a manner as to provide the excitement of a real time game. *See abstract; fig. 9; 1:21-58; 8:21-58.*

In view of *Luciano*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Scagnelli*, wherein players at remote terminals participate in a lottery, to add the feature of recording of the lottery drawings associated with the lotteries in which the user participated. As suggested by *Scagnelli* recording the results of a lottery drawing for display enhances the lottery system by providing the excitement of a real time game. *See abstract; fig. 9; 1:21-58, 8:21-58.*

The lottery system suggested by the combination of *Scagnelli* with *Luciano*, wherein lottery results are recorded and displayed on a video lottery terminal, describes all the features of the claim except the recording being in a multimedia format. More specifically, *Luciano* teaches providing entertaining electronic display. *See col. 1:53-56.* However, the reference does not describe in detail the format of the electronic display. Regardless, it would have been obvious to an artisan at the time of the invention to provide a multimedia display based on the ordinary knowledge of an artisan.

At the time of the invention it was notoriously well known in the art to implement electronic displays for entertainment devices using a combination of audio and video displays in order to enhance the stimulation of players' senses. For example, gaming devices and video game use video, audio and musical outputs to provide a more stimulating user interfaces. Hence, the examiner takes official notice

that it was within the ordinary knowledge of an artisan at the time of the invention to employ a multimedia format in an electronic entertainment display.

Consequently, it would have been obvious to an artisan at the time of the invention to modify the lottery system suggested by combination of *Scagnelli* with *Luciano*, wherein lottery results are recorded and displayed on a video lottery terminal, to add the feature of the recording being in a multimedia format enhance the stimulation of players' senses.

Claims 8, 18, 40 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Scagnelli* in view of *SGI Insights*, Scientific Gaming International, vol. 1, issue no. 5 (Jan. 1999).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 10, 20, 39, 42 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Scagnelli* in view of McCollom et al., U.S. Patent Application Publication 2002/001623 A1 (Jan. 24, 2002).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Response to Arguments

In regards to claims 1, 11, 33 and 49: The applicant argues that the claimed invention is distinguished from *Scagnelli* because the reference fails to disclose a display. More specifically, the applicant asserts that *Scagnelli* is directed towards a telephone-based system and that "nothing in Scagnelli shows or suggests the use of a display....". The examiner respectfully disagrees. The features

upon which applicant relies are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).* In this case, the claims merely require that users "participate on a display." The claims do not limit the type of display to a particular type of display (e.g. video, audio, tactile, etc.). *Scagnelli* allows a user to participate on an audio display. *See col. 2:1-45.* Hence the rejection is maintained because *Scagnelli* anticipates the feature of a display.

The applicant argues further that the secondary embodiment disclosed by *Scagnelli*, wherein the user-equipment is a special-purpose computer does not describe or suggest the computers having displays. The examiner respectfully disagrees. The specification need not disclose what is well known in the art. *See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).* In this case, *Scagnelli* discloses a preferred embodiment based on touch-tone telephones. Additionally, *Scagnelli* discloses a secondary embodiment employing computer terminals specialized for playing lotteries. *See col. 3:42-46.* These computers include, but are not limited to a processor which takes the place of the telephone and a keyboard, which takes the place of the keypad. As disclosed by *Scagnelli*, at the time of the invention it was known for lottery systems to employ a network of computers specialized for offering lotteries and providing interactive displays. *See col. 1:19-57.* Just as a telephone requires a handset allowing communication with the user, a specialized computer requires a some means for the same purpose. At the time of the invention, it was typical for computers to provide CRT displays as output devices to communicate information to users. Hence it is implicit in *Scagnell*, wherein the lottery system is implemented using specialized computers, that the computers include a display.

The applicant argues still further that *Scagenelli* teaches away from the use of a display. The examiner respectfully disagrees. The argument is unpersuasive because the question whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis. *See Celeritas Technologies*

Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The prior art was held to anticipate the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."). See also Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Claimed composition was anticipated by prior art reference that inherently met claim limitation of "sufficient aeration" even though reference taught away from air entrapment or purposeful aeration.)

Consequently, for the reasons given above, the rejection of the claims is maintained.

In regards to claims 21, 27, 43 and 59, the applicant argues that the claims, as amended, are distinguished from *Walker* because the reference fails to disclose or suggest giving the user the ability to specify conditions under which he wishes to participate in the lottery via user equipment on which the interactive wager application is at least partially implemented. The examiner respectfully disagrees. *Walker* discloses a conditional lottery system wherein the user interacts with the system via user equipment to set conditions under which the user automatically participates in the lottery on the behalf of the user when the conditions have been met. *See col. 2:36-3:35.* More specifically, the equipment with which the user interacts is comprised of, at least, entry forms. *See id.* Hence, the rejection is maintained because *Walker* teaches every feature of the claim.

Notably, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).* In this case, it appears that applicant assume that the claims requires elements such as an electronic data processor and software instructions stored on a computer-readable medium for execution by an electronic data processor. However, the examiner does not find any such features in the claims.

Consequently, for the reasons given above, the rejection of claims 21 and 27 is maintained.

In regards to claims 6, 16, 38 and 54: The applicant's arguments have been considered but are moot in view of the new grounds of rejection.

In regards to claims 10, 20, 42 and 58: The applicant argues that the claims are distinguished from the prior art because the references does not teach or suggest all the features of the claims. More specifically, the applicant asserts that *McCollom* does not give the user the ability to finalize a wager at a later time, nor remind the user to finalize a wager. The examiner respectfully disagrees. In response to applicant's arguments against *McCollom* individually, one cannot show nonobviousness by attacking a reference individually where the rejection is based on a combination of references. *See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).* The standard of patentability is what the prior art taken as a whole at a time prior to the invention suggests to an artisan. In this case, *Scagnelli* discloses a lottery system in which players located at remote terminals interact with a display to purchase lottery entries over the Internet. *See col. 3:34-49. McCollom* teaches an analogous system for making purchases over the Internet wherein users are given the ability to finalize a purchase at a later time and reminded the user to finalize the purchase. In particular, the reference allows users to place purchases in a "shopping basket" or "wish list" for later purchase. *See fig. 13, 14, 17.* The system's display provides an indication reminding the user that the purchase is not finalized. *See fig. 21, 22; p. 8, ¶ 0107.*

McCullom generally describes methods for making purchases over the Internet through an interactive user interface. Purchasing lottery entries through the Internet is merely a subset of online shopping. The methods disclosed in *McCullom* to store, finalize and receive reminders of purchases is equally applicable lottery entries over the Internet as it is to distributing coupons or selling books. Thus, in this case the combination of *Scagnelli* with *McCollom*, when taken as a whole, suggests to an artisan at

a time prior to the invention a lottery system allowing users to purchase lottery tickets over the Internet wherein user may finalize wagers at a later time and be reminded of the need to finalize wagers. As taught by *McCollom*, the modification would improve the system by allowing users to browse, assemble and store items until the time the elect to make a purchase. *See p.10, ¶¶ 0132-0137.*

Consequently, for the reasons given above, the rejection of the claims is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9302 for regular communications and 703 872 9303 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.

S.A.
July 30, 2003

MARK SAGER
PRIMARY EXAMINER